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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205331
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK AND TRIAL APPEAL BOARD

Teresa H. Earnhardt,	)	Consolidated Opposition Nos.
	)	91205331 (parent) and 91205338
Opposer,	)	
	)	In the matter of:
	)	
v.	)	Application Serial No. 85/383,910
	)	Mark: EARNHARDT COLLECTION
Kerry Earnhardt, Inc.,	)	(Intl. Class 20)
	)	
	)	Application Serial No. 95/391,456
Applicant.	)	Mark: EARNHARDT COLLECTION
	)	(Intl. Class 37)

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**REPLY BRIEF ON BEHALF OF OPPOSER**

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## **I. PRELIMINARY REMARKS**

Unfortunately, Applicant seems to have decided to use this proceeding as a vehicle for publicly attacking Opposer personally. Opposer will not respond in kind.

Instead, Opposer submits the following argument pertaining to the Section 2(e)(4) issue, and Opposer rests on her previously submitted argument pertaining to the Section 2(d) issue. Lanham Act, 15 U.S.C § 1052 (2012).

## **II. WHEN USED IN CONJUNCTION WITH THE LISTED GOODS AND SERVICES, THE COMPOSITE DESIGNATION EARNHARDT COLLECTION IS PRIMARILY MERELY A SURNAME**

When used in conjunction with the listed goods and services (namely, furniture and the construction of custom homes), the composite designation EARNHARDT COLLECTION, considered as a whole, is primarily merely a surname. Without question, the term “EARNHARDT” itself is primarily merely a surname. Moreover, the term “COLLECTION,” when used in conjunction with furniture or custom home construction services, is a generic or apt descriptive term which, to the relevant public, connotes a group or portfolio of furniture items or custom homes. Together, the primary connotation of the phrase EARNHARDT COLLECTION, when used in conjunction with furniture or custom home construction services, is that the furniture goods or the custom homes are a portfolio of such goods or homes sponsored by one or more persons having the surname EARNHARDT. As such, considered as a whole, and considered in the context of the particular listed goods and services of the opposed applications, the designation EARNHARDT COLLECTION, like the term EARNHARDT, is primarily merely a surname.

**A. The Controlling Legal Principles**

“A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009-10 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). “On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1616 (TTAB 2010) (quoting *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978)), *vacated-in-part on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

A generic term is a term, often used as a noun, which connotes what the goods or services are, rather than identifying the source or sponsor of those goods or services.

Such a term can never be a proprietary branding device. The critical inquiry in determining whether a term is generic is whether the evidence shows that members of the relevant public primarily use or understand the term to refer to the category or class of goods or services in question. *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re Women's Publ'g Co.*, 23 USPQ2d 1878, 1877 (TTAB 1992). However, the fact that the term may not have only one meaning or refer to only one particular genus of goods does not preclude its characterization as a generic term, nor is it necessary that the term be the only term that can be used to refer to such a genus. *Clairol, Inc. v. Roux Distrib. Co.*, 280 F.2d 863, 126 USPQ 397, 398 (CCPA 1960) (there may be a number of generic terms for a given genus of goods or services). Moreover, the meaning of the term with reference to the context in which it is used, not in the abstract, must be considered in determining whether the term is a generic term or a common descriptive term (sometimes referenced as an "apt descriptive" name). *Questor Corp. v. Dan Robbins & Assocs., Inc.*, 199 USPQ 358, 364 (TTAB 1978), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979)

If a composite designation is comprised of a surname coupled with a generic term, the composite designation is deemed unregistrable because, as a whole, it is primarily merely a surname. If instead a composite designation is comprised of a surname coupled with a term that is merely descriptive of the relevant goods or services, it must be determined whether the inclusion of that descriptive term diminishes the primary significance of the composite designation as a surname. *Miller v. Miller*, 105 USPQ2d 1615, 1622 (TTAB 2013).



**B. The Term EARNHARDT Is Primarily Merely a Surname**

For the reasons stated in Opposer's opening brief, and based upon the evidence referenced therein (Opposer's Br. pp. 9-12), there is no serious question whether the public will perceive the term EARNHARDT primarily merely as a surname. In fact, Applicant, in its brief, does not argue or even suggest that the evidence is insufficient to support such a finding. Instead, this issue is tacitly conceded by Applicant.

**C. Hutchinson Technology Does Not Support Applicant's Contention**

In its brief, Applicant relies primarily, if not entirely, on the *Hutchinson Technology* decision of the Court of Appeals for the Federal Circuit to support its contention that EARNHARDT COLLECTION, as used in conjunction with furniture and custom home construction services, is not primarily merely a surname. However, in doing so, Applicant misreads that court's analysis and decision.

The *Hutchinson Technology* case involved an application to register the composite designation HUTCHINSON TECHNOLOGY for use on the following goods: "etched metal electronic components; flexible circuits; actuator bands for disk drives; print bands; increment discs; [and] flexible assemblies for disk drives \*\*\*[.]" *In re Hutchinson Tech., Inc.*, 852 F.2d 552, 553, 7 USPQ2d 1490, 1491 (Fed. Cir. 1988). The TTAB had affirmed the examiner's refusal to register the mark "because it found that the term 'technology' is commonly used in connection with goods similar to those listed in Hutchinson's application." [Emphasis added] *Id.*, 852 F.2d at 553. The Federal Circuit faulted the Board for the particular reasoning by which the Board found the term "Technology" to be generic or merely descriptive. Contrary to that reasoning, the court held that common usage in connection with similar goods does not necessarily inform the

conclusion that a term is generic or descriptive of an applicant's goods. *Id.*, 852 F.2d at 554 (“[T]he fact that the term ‘technology’ is used in connection with computer products does not mean that the term is descriptive of them”). Instead, a term is merely descriptive if it conveys an immediate idea of some characteristic, quality or ingredient of the goods or services. *Id.*, 852 F.2d at 555. Thus, the Federal Circuit remanded the case to the Board for an application of the proper test for descriptiveness vis-a-vis the “common usage in connection with similar goods” test that had been applied by the Board in the first instance.

Applicant misreads and contorts the court's analysis and decision in *Hutchinson Technology*. For instance, Applicant begins by stating that the court held in *Hutchinson Technology* that “when a mark consists of a surname with additional wording that is **not generic**, it is neither primarily nor merely a surname, and thus Section 2(e)(4) is inapplicable.” Applicant's Br. p. 10, citing *Hutchinson Technology*, 852 F.2d at 554. Similarly, Applicant (again citing *Hutchinson Technology*, 852 F.2d at 554) asserts, “Thus the inclusion of an additional term, **unless that term is generic**, negates a claim that the mark is primarily merely a surname. Applicant's Br. p. 12. That is not what the Federal Circuit held, and that is not an accurate statement of the law.

Instead, as noted above, the Federal Circuit held that it was wrong to conclude that a term is descriptive because the term is commonly used in connection with similar goods. *Id.*, 852 F.2d at 554. Moreover, Applicant's summary of the law is incomplete. It is erroneous to argue (as Applicant argues) that, as a matter of law, if the term accompanying the surname is “**not generic**,” then the composite term may not be primarily merely a surname. Rather, if the accompanying term is **either generic or**

**descriptive** of the subject goods or services, then the composite term *may* be primarily merely a surname. Indeed, the court in *Hutchinson Technology* reviewed and commented on the evidence that the term “Technology,” as used in connection with the particular goods listed in the subject application, might be *merely descriptive* of those goods, rather than looking only to see whether the term was *generic* for those goods. *Id.*, 852 F.2d at 554-55. Thus, contrary to Applicant’s argument, it is highly relevant whether the non-surname term is either generic *or descriptive* of the listed goods or services.<sup>1</sup> Moreover, while the frequency of common use does not mandate a conclusion that the term is generic or descriptive, *Hutchinson Technology* does not make the evidence of such use relevant in determining what connotation is carried by the term or a composite designation incorporating the term.

**D. The Correct Analysis In This Case**

Other serious flaws further undermine Applicant’s argument. For example, Applicant misconstrues the relevant inquiry for determining whether a term is to be deemed “merely descriptive.” As noted above, whether a particular term is merely descriptive is determined in relation to the goods or services for which registration is sought, not in the abstract or on the basis of guesswork. *I.e.*, the question is whether *someone who knows what the goods or services are* will understand the mark to convey information about them. *DuoProSS Meditech Corp.*, 695 F.3d at 1254; *Abcor Dev. Corp.*, 588 F.2d at 814; *Remacle*, 66 USPQ2d at 1224; *Tower Tech. Inc.*, 64 USPQ2d at 1316-17; *Patent & Trademark Servs. Inc.*, 49 USPQ2d at 1539. Notwithstanding this

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<sup>1</sup> Inasmuch as a grouping or portfolio of furniture goods or custom homes may be considered a subcategory of those goods or custom homes, the “generic” characterization also may be applied to the term “Collection” in these contexts. However, it is not necessary to do so in this proceeding because of the highly descriptive nature of the term “Collection” in these contexts and as used in the composite mark.

well-recognized principle, Applicant argues instead that EARNHARDT COLLECTION cannot be considered to be primarily merely a surname because “the term ‘Collection’ is a ‘broad term’ that encompasses many types of goods” (Applicant’s Br. p. 14), and “the term ‘Collection’ does not refer to, or immediately convey, any particular type of good or service.” (Applicant’s Br. p. 15) Applicant also argues rhetorically that “[i]f a member of the public were offered ‘a collection,’ her most likely reaction would be to ask, ‘A collection of what?’” (Applicant’s Br. p. 16) That is not the test for descriptiveness. Nor does it matter that, as Applicant argues, it and its licensee only “sell” “individual custom homes” rather than “groupings” of custom homes. (Applicant’s Br. p. 16) Applicant and its licensee offer and promote the entire portfolio of homes (*i.e.*, the entire “collection”) in soliciting the sales of individual units.

Instead, as applied to the facts of this case, the descriptiveness inquiry is whether someone who knows that Applicant’s goods are furniture (or knows that Applicant sponsors custom home construction services) will understand the composite designation EARNHARDT COLLECTION to convey information concerning the composition, ingredients, or other characteristics of those furniture goods or home construction services. Applicant’s own disclaimer of the term “Collection” because of its merely descriptive character; the dictionary evidence cited in Applicant’s own brief; the dictionary evidence submitted by Opposer; the numerous examples of such usage by third-parties submitted by Opposer; and evidence of Applicant’s own representatives’ frequent usage of the term “Collection” in the context of their own products and services --- all inform the conclusion that members of the general public encountering the use of EARNHARDT COLLECTION in conjunction with furniture goods or custom home

services would readily perceive that the term refers to a group or portfolio of such goods or home designs sponsored by one or more individuals having the surname EARNHARDT.<sup>2</sup> Moreover, “[t]here is no unique or incongruous meaning created” by which the combination of “Earnhardt” and “Collection” might be saved from such a connotation. *Tower Tech*, 64 USPQ2d at 1317-18. Thus, whether the individual term “Collection,” as used in this context, is characterized as “generic,” “aptly descriptive” or “merely descriptive” is of no great significance because, in any event and under any characterization, the composite designation EARNHARDT COLLECTION, as used on furniture goods or in conjunction with home construction services, retains and is dominated by the surname significance of “EARNHARDT.” As such, the composite designation is primarily merely a surname and, as a matter of law, is not registrable for use on or in conjunction with those particular goods or services.<sup>3</sup>

### III. CONCLUSION

Opposer submits that the oppositions should be sustained, and Applicant’s applications for registration of EARNHARDT COLLECTION should be refused.

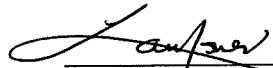
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<sup>2</sup> While Applicant is correct in pointing out that TMEP § 1211.01(b)(vii) provides that registration of a composite mark that combines a surname with a merely descriptive term, should require a disclaimer, but is otherwise proper for registration (Applicant’s Br. p. 18), that assertion (and the cited provision) comes with an implicit caveat: The composite mark is otherwise proper for registration *unless*, with the disclaimed descriptive term, the composite designation, as used on or in conjunction with the listed goods or services, is primarily merely a surname.

<sup>3</sup> Similarly, based on such forms of evidence, the designation “COLLECTIVE CHEESE,” when used on cheeses and other foods, was held to be merely descriptive of those goods because the designation carried the connotation (with respect to at least some of the listed goods) that they originate from a collective farm. *In re Whole Foods Market IP, L.P.*, No. 85820807 (TTAB 2015).

Dated: March 27, 2015.

Respectfully submitted,



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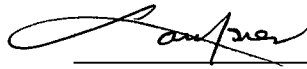
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**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing *Reply Brief on Behalf of Opposer* was duly served on Applicant by depositing a copy of same in the United States mail, first-class postage prepaid, on the 27<sup>th</sup> day of March, 2015, addressed to Applicant's attorneys of record as follows:

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